

REMARKS

This amendment is filed with a Request for Continued Examination in the above-identified patent application. The amendment is also in response to the final Official Action mailed on **March 24, 2004** (Paper No. 5)

Reconsideration of the application in light of the forgoing amendments and the following remarks is respectfully requested. Claims 47 and 59 are cancelled by the present amendment. Therefore, Claims 1-46 and 48-58 are currently pending for the Examiner's consideration.

With regard to the prior art, the final Office Action rejected claims 23-25, 27, 30, 31, 35, 37, 40, 42, 47, 48, 49, 51-53 and 55-58 as anticipated under 35 U.S.C. § 102(e) by U.S. Patent No. 6,678,463 to Pierre et al. ("Pierre"). For at least the following reasons, this rejection is respectfully traversed.

Independent claim 23 recites:

A personal video recorder comprising:
an input for receiving an audiovisual signal and an output for outputting said audiovisual signal;
a buffer for buffering said audiovisual signal, said buffer retaining a portion of said audiovisual signal after that portion has been output by said recorder;
a data storage unit; and
a processor that receives input from a user input device;
wherein, upon receipt of a user command input through said user input device, said processor records a segment of said audiovisual signal in said data storage unit, said segment of said audiovisual signal comprising:
a first predetermined amount of said portion of said audiovisual signal retained in said buffer; and
a second predetermined amount of said portion of said audiovisual signal output by said recorder after receipt of said user command;

wherein said first and second predetermined amounts are set by user input through said user input device.
(emphasis added).

Claims 51 and 55 recite similar subject matter. For example, claim 51, a method claim, recites “receiving user input through said user input device that specifies said first and second predetermined amounts.” Claim 55 recites “means for receiving user input through said user input device to control a length of said first and second predetermined amounts.”

Turning to the cited prior art, Pierre is functionally the same as the Wilhelms reference that was cited and distinguished previously. In contrast to the claimed invention, Pierre teaches that:

The automatic recording of a program in temporary storage at the start of the program without any action by the viewer, allows the viewer to decide to record the program after the start of the program without losing any of the previously broadcast content. Once the viewer decides to record the program, the remainder of the program will be recorded in a semi-permanent storage area in the storage device 18, as described below.
(Col. 6, lines 29-36).

After the recording is complete the first portion of the program, which was previously stored in the circular buffer 90, will be copied into the semi-permanent storage area, preferably in front of the allocated space within the semi-permanent storage 94. In this way, the first portion is physically combined with the second portion of the program to form a contiguous recording.
(Col. 6, lines 61-67).

Pierre does teach that the user can set the “first predetermined amount,” the amount of the program stored before a record command is entered. (Col. 6, lines 9-11). However, Pierre does not teach or suggest that the user can set the “second predetermined amount,” the amount of a program stored after a record command is entered. According to Pierre, after a record command is entered, the remainder of that program is recorded, subject only to storage space limitations. Pierre does not teach or suggest that only some portion of the program in an amount specified by a user is stored after receiving a record command as claimed.

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). *See* M.P.E.P. § 2131. Therefore, the rejection of claims 23-29, 51 and 55 based on Pierre should be reconsidered and withdrawn.

Claim 30 recites:

A personal video recorder comprising:
an input for receiving an audiovisual signal and an output for outputting said audiovisual signal;
a buffer for buffering said audiovisual signal, said buffer retaining a portion of said audiovisual signal after that portion has been output by said recorder;
a data storage unit; and
a processor that receives input from a user input device;
wherein, upon receipt of a user command input through said user input device, said processor records a segment of said audiovisual signal in said data storage unit, said segment of said audiovisual signal comprising:
a first predetermined amount of said portion of said audiovisual signal retained in said buffer; and
a second predetermined amount of said portion of said audiovisual signal output by said recorder after receipt of said user command; and
wherein said processor associates an identifying label with each said segment of said audiovisual signal recorded in said data storage unit such that segments taken from a single audiovisual program can be distinguished.
(emphasis added).

Claims 52 and 56 recites similar subject matter.

In contrast, Pierre merely teaches that "The storage device 18 typically contains a plurality of programs which have been recorded by a viewer. The recordings are associated with identifying information that may have been copied or modified from the signaling information." (Col. 5, lines 51-55). Thus, Pierre only teaches associating identifying information with completed recordings of an entire program.

Pierre does not teach or suggest the claimed associating of “an identifying label with each said *segment* of said audiovisual signal recorded in said data storage unit *such that segments taken from a single audiovisual program can be distinguished.*” Therefore, for at least this reason, the rejection of claims 30-41, 52 and 56 based on Pierre should be reconsidered and withdrawn.

Claim 42 recites:

A personal video recorder comprising:
an input for receiving an audiovisual signal and an output for outputting said audiovisual signal;
a buffer for buffering said audiovisual signal, said buffer retaining a portion of said audiovisual signal after that portion has been output by said recorder;
a data storage unit; and
a processor that receives input from a user input device;
wherein, upon receipt of a user command input through said user input device, said processor records a segment of said audiovisual signal in said data storage unit, said segment of said audiovisual signal comprising:
a first predetermined amount of said portion of said audiovisual signal retained in said buffer; and
a second predetermined amount of said portion of said audiovisual signal output by said recorder after receipt of said user command;
wherein said user input device comprises a remote control unit and said recorder comprises a receiver for receiving input from said remote control unit, wherein said remote control unit further comprises a dedicated button for issuing said user command to record a segment of said audiovisual signal.
(emphasis added).

In contrast, the cited prior art fails to teach or suggest the claimed dedicated button for issuing a user command to record a segment of audiovisual signal. Moreover, the final Office Action fails to indicate how or where this subject matter is taught by the prior art. The final Office Action refers only to Pierre, which includes no teaching of the claimed dedicated button. Consequently, the rejection of claims 42-46, 48-50, 53 and 54 based on Pierre should be reconsidered and withdrawn.

Claim 57 recites:

A method of operating a personal video recorder that processes an audiovisual signal and selectively records said audiovisual signal in a data storage unit, said method comprising:

retrieving an audiovisual program stored on said data storage unit in said recorder;

outputting said audiovisual program;

receiving a user command through a user input device; and,

in response to said user command, storing a separate recording of a segment of said audiovisual program in said data storage unit, said segment comprising a first predetermined amount of said audiovisual program output prior to receipt of said user command and a second predetermined amount of said audiovisual program output after receipt of said user command.

Applicant wishes to point out that claim 57 recites replaying an audiovisual program that is already stored on the data storage unit of the PVR and then capturing segments of that program during replay based on user commands and storing separate recordings of the captured segments.

In contrast, Pierre only teaches a method of recording broadcast programs that are being received from a broadcast station (12). Pierre does not teach or suggest a method of capturing segments of a program that is being replayed from a PVR's own data storage unit as recited in claim 57. Consequently, the rejection of claims 57 and 58 based on Pierre should be reconsidered and withdrawn.

Claims 1-3, 5, 9, 11-13, 17-18, 15, 21 and 22 were rejected under 35 U.S.C. § 103(a) over the combined teachings of Pierre and U.S. Patent No. 5,438,423 to Lynch et al. ("Lynch"). The other dependent claims are further rejected based on Pierre and other various secondary references. For at least the following reasons, these rejections are also respectfully traversed.

Claim 1 recites:

A personal video recorder having a user-controlled data capture function, the recorder comprising:
an input for receiving an audiovisual signal and an output for outputting said audiovisual signal;
a buffer for buffering said audiovisual signal, said buffer retaining a portion of said audiovisual signal after that portion has been output by said recorder;
a data storage unit; and
a processor that receives input from a user input device;
wherein, upon receipt of a user command input through said user input device, said processor records a segment of said audiovisual signal in said data storage unit, said segment of said audiovisual signal comprising:
a first predetermined amount of said portion of said audiovisual signal retained in said buffer, wherein said first predetermined amount is less than all of said portion of said audiovisual signal retained in said buffer; and
a second predetermined amount of said portion of said audiovisual signal output by said recorder after receipt of said user command.

Independent claims 11 and 17 recite similar subject matter.

According to the final Office Action, Pierre fails to teach or suggest that less than all of the audiovisual signal retained in the buffer is moved for storage in the data storage unit in response to a user command. According to the final Office Action, however, Lynch teaches this subject matter in col. 3.

Applicant has reviewed col. 3 of Lynch and feels that the final Office Action is attempting to read more into Lynch that is actually taught. In pertinent part, col. 3 of Lynch reads:

If the viewer wishes to save a portion of the video program, a save command may be used to cause a segment, either of fixed or variable duration, of the video program to be transferred to the static buffer 22, which may be a reserved portion of the dynamic buffer 16 as determined by the viewer. The use of a portion of the dynamic buffer 16 as the static buffer 22 reduces the amount of video program material available to the viewer at any one time. The saved video from the static buffer 22 may be viewed upon command at any desired rate, realtime, slow motion or fast forward, and in either direction, forward or reverse. If permanent saving is desired, the video from the static buffer 22 may be transferred to the VCR 24. Of course the video from the dynamic

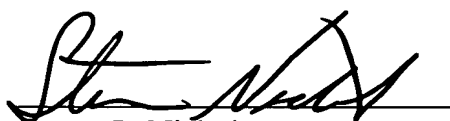
buffer 16 may also be transferred to the VCR 24 directly rather than being buffered by the static buffer 22.
(Col. 3, lines 22-38).

Nowhere does Lynch teach or suggest that less than all the contents of the dynamic buffer are transferred to the static buffer when a save command is received. Lynch simply does not teach or suggest a buffer of constant size where less than all the contents of the buffer are saved in response to a user command as claimed.

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). Therefore, the rejection of claims 1-22 based on the combination of Pierre and Lynch should be reconsidered and withdrawn.

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If any fees are owed in connection with this paper which have not been elsewhere authorized, authorization is hereby given to charge those fees to Deposit Account 18-0013 in the name of Rader, Fishman & Grauer PLLC. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,



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